



UNITED STATES PATENT AND TRADEMARK OFFICE

A-7

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/701,211

11/04/2003

Andreas Derr

WEM-05002

5179

7590

01/05/2005

Choate, Hall & Stewart
Patent Group
Exchange Place
53 State Street
Boston, MA 02109-2804

EXAMINER

CHANG, YEAN HSI

ART UNIT

PAPER NUMBER

2835

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/701,211

Applicant(s)

DERR ET AL.

Examiner

Yean-Hsi Chang

Art Unit

2835

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 65-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 65-66, 68-74, 78, 80, 82-83, 85, 89, 91 and 95 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-5 and 11 of U.S. Patent No. 6,665,174 B1 ('174). Although the conflicting claims are not identical, they are not patentably distinct from each other because all claimed subject matters are covered in the claims of '174 in different arrangement.

Claim Rejections - 35 USC § 102

Art Unit: 2835

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 65-66, 69-70, 72-73 and 75-77 are rejected under 35 U.S.C. 102(b) as being anticipated by Mehnert (US 5,018,049).

Mehnert teaches a portable electrical control and display device (fig. 1) comprising: an indicator element (6), a control element (4), a housing (1) that contains said indicator element and said control element, said housing including a transparent protective sight glass (8), and at least one sealing device (2) being cylindrical in shape, that closes said housing in a water-tight manner, said at least one sealing device including one of a plug and ring which can be pushed into the housing on at least one side, said one of the plug and the ring engaging in the housing when pushed in (see col. 4, lines 18-27) (claims 65 and 69); wherein said indicator element is a visual indicator panel (underneath 6) (claim 66); wherein the housing is at least partially made of a colored material (see col. 3, lines 35-36) and wherein said transparent protective sight glass is connected to the housing in an area of the indicator element (at 7, fig. 1) (claim 70); wherein said housing includes a sealing lip (fig. 1) that engages said at least one sealing device when said sealing devices is pushed into said housing (claim 72); a sleeve (3) that accommodates said indicator element and said control element and supports said housing (fig. 1) (claim 73); wherein said housing is in two parts (8 and 9) that are attached together (fig. 1) (claim 75); wherein said two parts of the housing are

Art Unit: 2835

attached together in a water-tight manner (see col. 3, lines 37-39) (claim 76); and wherein said sight glass is disposed in one of the parts (part of 8) (claim 77).

5. Claims 78-80, 83 and 86-88 are rejected under 35 U.S.C. 102(b) as being anticipated by Mehnert.

Mehnert teaches a portable electrical control and display device (fig. 1) comprising: an indicator element (6), a control element (4), a housing (1) that contains said indicator element and said control element, said housing including a transparent protective sight glass (8), a sleeve that accommodates said indicator element and said control element, and at least one sealing device (2) that closes said housing in a water-tight manner, said at least one sealing device including a peripheral groove (not labeled, shown in fig. 2) and a matching peripheral ridge (on the right end lip of 8) arranged at opposite locations on the housing and the sleeve, wherein when the housing and sleeve are joined together, the ridge engages the groove (claims 78 and 79); wherein said indicator element is a visual indicator panel (shown in fig. 1) (claim 80); wherein the housing is at least partially made of a colored material (see col. 3, lines 35-36) and wherein said transparent protective sight glass is connected to the housing in an area of the indicator element (at 7, fig. 1) (claim 83); wherein said housing is in two parts (8 and 9) that are attached together (fig. 1) (claim 86); wherein said two parts of the housing are attached together in a water-tight manner (see col. 3, lines 37-39) (claim 87); and wherein said sight glass is disposed in one of the parts (part of 8) (claim 88).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 65, 67-68, 71, 73-74, 78, 81-82 and 84-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehnert in view of White et al. (US 6,532,152 B1).

Mehnert teaches a portable electrical control and display device (fig. 1) comprising: an indicator element (6), a control element (4), a housing (3) that contains said indicator element and said control element, said housing including an opening (7), and at least one sealing device (2) that closes said housing in a water-tight manner, said at least one sealing device including one of a plug and ring which can be pushed into the housing on at least one side, said one of the plug and the ring engaging in the housing when pushed in (see col. 4, lines 18-27), and a sleeve (1) that accommodates said indicator element and said control element (claims 65, 73 and 78); wherein said housing is made of temperature-resistance material that is resistant to a temperature of at least 70 degrees Celsius (see col. 3, lines 10-11; and metal is considered as temperature resistant to at least 70 degrees Celsius) (claims 71 and 84); and wherein the housing and the sleeve are similar in shape and the housing encloses the sleeve in an essentially form-fitting manner (fig. 1) (claims 74 and 85).

Mehnert fails to teach the housing including a transparent protective sight glass, the indicator element being an acoustic indicator, and the control element being a keyboard.

White teaches a portable electronic control and display device (200, fig. 2) comprising: a housing (202) including an aperture (210) with a transparent protective sight glass (212) (claims 65 and 78); an acoustic indicator (218) (claims 67 and 81); and a control element (220) being a keyboard with at least one keypad (claims 68 and 82).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Mehnert with the device taught by White such that the opening of the housing is covered with protective glass for being completely water-tight; and for indicating specifically the types of display element and control element.

8. Claims 89-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehnert.

Mehnert teaches a portable electrical control and display device (fig. 1) comprising: an indicator element (6), a control element (4), a housing (1) that contains said indicator element and said control element, said housing including a transparent protective sight glass (8), a sleeve that accommodates said indicator element and said control element, said housing including a ridge (12), wherein when the housing and sleeve are joined together, the ridge engages the sleeve (claim 89); wherein said housing is made of a softer material than said sleeve (see col. 3, lines 1-11) (claim 90);

Art Unit: 2835

wherein said ridge forms a groove (13) in said sleeve when said housing and said sleeve are joined together (claim 91); wherein said housing is in two parts (8 and 9) that are attached together (claim 92); wherein said two parts of the housing are attached together in a water-tight manner (see col. 3, lines 37-39) (claim 93); wherein said sight glass is disposed in one of the parts (on 8) (claim 94); and wherein said sleeve includes a groove (13) and wherein said ridge engages said groove when said housing and said sleeve are joined together (claim 95).

Mehnert fails to teach the ridge being on the sleeve and the groove being on the housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the ridge and the groove rearranged on the sleeve and the housing, respectively, since it has been held that rearranging parts of an invention involves only routine skill in the art. MPEP §2144.04 VI C.

Correspondence

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yean-Hsi Chang whose telephone number is (571) 272-2038. The examiner can normally be reached on 07:30 - 16:00.

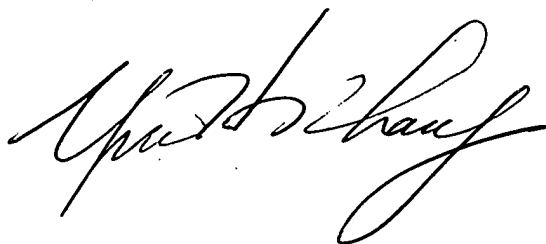
If attempts to reach the examiner by telephone are unsuccessful, the Art Unit phone number is (571) 272-2800, ext. 35. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3431 for regular communications and for After Final communications. There are RightFax numbers and

Art Unit: 2835

provide the fax sender with an auto-reply fax verifying receipt by the USPTO: Before-Final (703-872-9318) and After-Final (703-872-9319).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-8558.

Yean-Hsi Chang
Primary Examiner
Art Unit: 2835
January 3, 2005

A handwritten signature in black ink, appearing to read 'Yean-Hsi Chang', is written over a faint, curved line.